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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte RICHARD JOSEPH BENNETT, ALBERT A. TATE,
11 DAVID ANDREW RAPPERPORT, RYAN MICHAEL EASTMAN
12 and RANDALL SCOTT DEBOLD
13

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15 Appeal 2008-1903
16 Application 09/784,889
17 Technology Center 3600
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21 Oral Hearing Held: October 22, 2008
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25 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and STEVEN
26 D.A. McCARTHY, Administrative Patent Judges

27
28 ON BEHALF OF THE APPELLANT:
29

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36 The above-entitled matter came on for hearing on Wednesday, October 22,
37 2008, at the U.S. Patent and Trademark Office, 600 Dulany Street,
38 Alexandria, Virginia, before Virginia Johnson, Freestate Reporting, Inc.

PROCEEDINGS

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JUDGE CRAWFORD: Good morning, Mr. Gordon.

MR. GORDON: Good morning, Judge Crawford.

JUDGE CRAWFORD: We've discussed the, the case a little bit, so we are familiar with the issues. You can begin whenever you're ready.

MR. GORDON: Thank you. If you're ready.

JUDGE LORIN: Yes.

MR. GORDON: Thank you. Thank you very much, Judge Lorin, Judge Crawford, and Judge McCarthy. Again, my name is John Gordon and I represent the applicant this morning. In, in, in this matter, the Examiner has rejected all pending claims as anticipated by Schurenberg. Now as -- to maintain, to maintain an anticipation rejection, every limitation in each and every element as set forth in the claim has to be found in a single reference, and our position is that in each of the rejections the Examiner has overlooked a limitation -- at least one limitation in each of the claims.

If we want to look at the first independent claim, which is Claim 26, there are, there are actually two important limitations that we believe that the Examiner has overlooked. The first one is that the Examiner has said that the step of transmitting information through the network from the central computer to the client computer, including data for generating a test requisition and a label for use with a biological specimen, is only a step of transmitting information. The Examiner's position has been that it is proper to ignore the rest of that limitation which is that the information includes data for generating a test requisition and a label for use with, with a biological specimen.

1 There are limitations both on the time when the transmission can take
2 place and on the nature of the data that is transmitted, and it's not an answer
3 to this to say, as the Examiner has said, that the step of transmitted -- the
4 step of actually printing a label or generating a requisition is not claimed.

5 A functional limitation is proper, and it actually does impose
6 limitations both on the structure of the transmitting itself and on the
7 substance of the data that is transmitted. And given the nature of the flow in
8 Schurenberg, Schurenberg's data transmission cannot anticipate this. There
9 is no, there is no transmission of substantive data disclosed, either expressly
10 or inherently, in Schurenberg until after the test has been preformed and
11 there are test results to be delivered. And logically, this cannot happen
12 before the label has been printed and the requisition has been generated and
13 the test has been preformed.

14 The other limitation that the Examiner has overlooked has to do with
15 what makes the computer a central computer. The Examiner has
16 consistently said that the middleware server discussed in Schurenberg is the
17 central computer of Claim 26 and the other claims in this application. Now
18 plainly the middleware server is a computer, but what the Examiner has
19 never said is what makes it a central computer.

20 If you look at our application you see that, especially in the figures, it
21 is shown that, that our central computer is central. Information from the labs
22 go through it. Information from the insurance companies goes through it.
23 Information from the clients goes through it.

24 On the other hand, it's not clear in what sense the central computer in,
25 or the middleware server in Schurenberg is, is central.

1 JUDGE MCCARTHY: But, counsel, doesn't information from the
2 client applications and the laboratories pass through the client object server
3 110 as shown in Figure 3?

4 MR. GORDON: It may but it's not clear that it, that it has to, and it's
5 not good enough for it to be possible that it works this way.

6 JUDGE MCCARTHY: Well, doesn't Figure 3 show all the arrows
7 going through from the client applications to the rest of the system going
8 through that client object server?

9 MR. GORDON: It shows -- well, there are lots of things. They show
10 lots of arrows going through them and from them. You have, you have, you
11 have a, you have a data, you have a data object broker in Figure 4, I believe,
12 that has, that has -- that all the information from the labs goes through, and
13 this one could be as central as the other one. You have -- if I can look up the
14 figure, you have the object broker data server number 140 which is centrally
15 located with respect to the service provider, the remote servers, and the
16 remote servers have their data bases affiliated with them.

17 If you look at Figure 4, you have the HIE Cloverleaf Engine which all
18 the information from the labs goes through, and at least it's possible that all
19 the order information and billing information goes through.

20 Further --

21 JUDGE MCCARTHY: But, counsel, is there anything in Claim 26
22 which would require that there only be one central computer?

23 MR. GORDON: No, Judge McCarthy, but our point has been that --
24 our point has been consistently we don't know what the Examiner is saying
25 is central about the middleware server, and it's very difficult to respond to
26 an interpretation of a claim limitation if the Examiner won't give it to us. If

1 the Examiner's position is that the word central is, is essentially
2 meaningless, that's one thing, and we could respond to that. If the
3 Examiner's position is that it's central topologically, we could examine that.
4 We might have a response to that. We might not have a response to that.
5 But the point has been that, that we can't respond to a term interpretation
6 that we're not given by the Examiner.

7 JUDGE LORIN: Well, counsel, it's possible that the Examiner does
8 not understand what you mean by central computer. Can you tell us what
9 you mean?

10 MR. GORDON: Well, it -- in this case, it's -- there are several senses
11 in which it's central. I think that you can see from our figures that --
12 especially from, especially from Figure 1 that the central computer is
13 centrally located in terms of the data flow.

14 JUDGE LORIN: Well, let me stop you there for a second, counsel.
15 There are several senses. Aren't you suggesting there's some ambiguity in
16 how you use the word central?

17 MR. GORDON: Not if the --

18 JUDGE LORIN: I mean, the Examiner, the Examiner is having a
19 problem --

20 MR. GORDON: Right. Not, not --

21 JUDGE LORIN: -- with your defining it.

22 MR. GORDON: Not if the senses are consistent with one another. If
23 it's central in the sense of -- if it can be central in the sense of all the data
24 flowing through it, it can also be central in the sense of -- it can be, you
25 know, in a logical sense which is where all the data operations go through.
26 And if it's central in any or all of these -- if it's central in all of these senses,

1 then it's, then it's central. I don't think that there's necessarily an ambiguity
2 in it.

3 JUDGE LORIN: Well, let's not rely on anecdotal evidence. Let's
4 look at your specification. Do you have an explicit definition for what you
5 mean by "central computer?"

6 MR. GORDON: We have not explicitly defined the term "central."

7 JUDGE LORIN: Therefore the Examiner is open to using any
8 ordinary customary meaning for "central computer." Is that not correct?

9 MR. GORDON: Yes.

10 JUDGE LORIN: Thus, the Examiner can say that this computer that's
11 in this reference is a central computer. Why would the Examiner be wrong?

12 MR. GORDON: My -- our position right now is not necessarily that
13 the Examiner is wrong, it's that we don't know that the Examiner is using
14 "central" in its ordinary and reasonable meaning, and we have throughout
15 this process said, said that we don't know how this term is being construed.
16 And so we don't know, we don't know whether we agree with it or not.

17 JUDGE LORIN: The Examiner has shown you how he's construed
18 the central computer by pointing to the computer in the reference that the
19 Examiner is relying upon to meet that limitation. So the Examiner in fact
20 has done that. Why is the Examiner's construction -- the ordinary customary
21 meaning the Examiner has applied to that term -- why would that be wrong
22 in your view when in fact you have no explicit definition in the
23 specification?

24 MR. GORDON: But, but, Judge Lorin, our position -- I'm afraid I
25 have to take issue with your saying that the Examiner has applied an
26 ordinary and customary meaning, because "central computer" and

1 “computer” are not necessarily the same thing. And if the Examiner’s
2 position is that the ordinary and customary meaning of “central computer” in
3 this circumstance is a computer positioned the way we’ve described it, that’s
4 one thing. But the computer -- excuse me, the Examiner hasn’t explained
5 what makes -- what in this view is “central” about the central computer.
6 And again it could very well be that the Examiner’s position is that is simply
7 saying ordinary and customary meaning of central as applied to computer is,
8 is something that is anticipated by the middleware server of Schurenberg,
9 and that -- if that’s the Examiner’s position, you know, we can respond to
10 that.

11 JUDGE LORIN: If --

12 MR. GORDON: We, we haven’t been able -- I haven’t been able to
13 get the Examiner to address that in responding to the obviousness sections.

14 JUDGE LORIN: Well, if I’m understanding you correctly, counsel,
15 you give no definition. You don’t explain what the ordinary customary
16 meaning is. You use a word such as “central” to describe your computer,
17 and your, your -- we’re left with some broad indication that it’s central and
18 then you shift the burden to the examiner to explain to you what precisely
19 the Examiner means. So you don’t give a precise definition, but you shift
20 the burden to the Examiner to give you a precise definition. Is that what I’m
21 hearing you say?

22 MR. GORDON: What you’re hearing me say is that we have asked
23 the Examiner to explain what, what the Examiner -- how the Examiner is
24 interpreting the term.

25 JUDGE LORIN: But I’m asking you how you’re interpreting, and
26 you’re telling me there’s no definition. And you’re, you’re telling -- you’re,

1 you're also not telling me how you define it in the ordinary customary
2 meaning.

3 MR. GORDON: Well, my point here -- the only reason we are
4 bringing it up at the moment is because the Examiner has not, has not said so
5 much as I am giving the term "central" it's ordinary and customary meaning.
6 And that would be one thing, but the reason we bring it up on this appeal is
7 that we don't know even if that's what the Examiner has done to that term
8 and --

9 JUDGE CRAWFORD: So you're not even responding to whether or
10 not it is a central computer according to your definition because --

11 MR. GORDON: At, at this point we're not sure. And, and if, if I
12 may, I'd like to back up a bit because the architecture here is in our view
13 important. Schurenberg describes using a distributive application to provide
14 certain services related to health care. There are data flows conceivably all
15 over the place. There is a diagram showing a star topology in 1A [*sic*, in
16 Fig. 2].

17 On the other hand, we discuss, we discuss a lot of things that happen
18 at a central computer. There is analysis in Claim 27 that takes place at the
19 central computer, and we discuss that separately. There -- and there are
20 specific kinds of analysis that we discuss in Claims 28 and 29.

21 On the other hand, if you have the kind of thick client that is discussed
22 in Schurenberg analysis can be done at the client side. Data can be retrieved
23 directly from the client side. And the middleware server in Schurenberg is
24 described not necessarily as, as meeting these -- these central functions, but
25 as an object broker which has a specific role in a distributed object oriented
26 application.

1 I think the single most important indication of the differences in
2 architecture can be seen if you look at Figure 11. I'm sorry, not Figure 11.
3 If you look at Figure 5 in Schurenberg, which discusses the flow, and it is
4 discussed, it is discussed in paragraphs 52 through 58. And in this section,
5 particularly paragraph 53, it talks about the information may be stored
6 temporarily and batched later. Now for this to happen, the client has to be
7 able to receive all the information, analyze it and then at a later time -- it can
8 be right away, but it can be later, after the analysis has been performed at the
9 client, send the information on to the system. Now certainly one, one
10 consequence of that is, as we discussed before, the information coming back
11 from the system necessary to generate the requisition and to print the label.
12 But there are other claims, claims that we have argued separately that also
13 are -- in our view are allowable because there are limitations that necessarily
14 are not, are not anticipated given this architecture.

15 If you look at, say, Claim 27, analyzing the at least one query at the
16 central computer to verify that the requested laboratory test is payable by a
17 responsible party identified in the billing information. Well if you look at
18 the Examiner's arguments on behalf -- for these claims, the Examiner
19 essentially has read this to say, to read only that to verify that a responsible
20 party is identified in the billing information, but the analysis here involves
21 whether the claim is payable by that party and it has to take place at the
22 central computer.

23 Claims 28 and 29 which we've also discussed separately are examples
24 of specific kinds of analysis, for instance, to see whether the diagnosis code
25 corresponds to the test code in a way that it's been specified by the
26 responsible party.

1 Claim 29, the analysis is whether there is -- whether a maximum
2 number of tests per, per diagnosis code has been exceeded. This analysis
3 has to happen at the central computer according to our claims. According to
4 Schureberg, all that it shows is that this information is entered locally.
5 Because you have a thick client, even if there is an analysis done which
6 Schureberg doesn't, doesn't disclose -- Schureberg does not disclose
7 analyses of the kind that we have claimed. But it also does not disclose that
8 any kind of processing of this data takes place at the central computer which,
9 given the Examiner's interpretation, would be the middleware server.

10 Even -- now I, I did want to make special reference to Claims 28 and
11 29 because these talk about specific kinds of -- I'm sorry, Judge Crawford,
12 I'm sorry.

13 JUDGE CRAWFORD: No, go ahead.

14 MR. GORDON: You looked like you want to say something. Claims
15 28 and 29, they involve finding a correspondence between -- Claim 28
16 involves finding a correspondence between a test code and a diagnosis code.
17 Claim 29 involves finding a correspondence between a test code and a
18 maximum number of tests.

19 Now the Examiner's position on this has been that --essentially that
20 the requisition can hold both of these pieces of information in each case.
21 One case is that a requisition has a test code and a diagnosis code. And
22 Claim 29 is that a requisition has a, has a diagnosis code and that there is a,
23 there is another place where Schureberg describes a maximum number of
24 tests per requisition.

25 But coincidence is not the same as correspondence, and this reading is
26 inconsistent with the rest of the claim, much less the specification. There is

1 no -- again, there is no disclosure that this information is analyzed at the
2 central computer however one tries to define that. And there's no -- but
3 there's also no -- there's no correspondence.

4 You can't analyze. You can't, you can't perform an analysis
5 determining whether the responsible party will pay for a certain number of
6 tests simply by looking at whether a test code and a number of tests appear
7 on the same requisition. It's inconsistent with this specification and it's
8 inconsistent with the rest of the claim.

9 JUDGE MCCARTHY: Counsel, is there any definition of analyzing
10 or analysis in the specification -- in your specification?

11 MR. GORDON: Well, there's certainly examples of it. We don't
12 define the term analyze as such, but we talk about how the central computer
13 verifies that the claim is payable, and we give specific examples of the kinds
14 of analysis that can take place. This is -- this kind of analysis is not -- any
15 kind of analysis is not described in Schurenberg. The fact that payment
16 verification can happen is mentioned in Schurenberg, but there is no
17 disclosure of analysis taking place at the middleware server. There's no
18 disclosure of any specific kind of analysis. So what you really have is
19 circumstance where we claim a transmission of information that includes --
20 to from point A to point B. And we claim use of this information for a
21 particular purpose, and Schurenberg doesn't claim -- doesn't -- claim and
22 doesn't explicitly disclose and it certainly doesn't inherently include either
23 part.

24 It doesn't say this analysis has -- any analysis has to take place at the
25 central -- at a central computer, much less that this particular information is
26 sent there in the first place.

1 And I'd also like to -- in, in this regard, I'd also like to talk about
2 Claim 32 which we do argue separately. Transmitting a request for -- which
3 includes -- transmitting a request for additional diagnosis information if the
4 requested laboratory test is not payable by the identified responsible party.
5 In response to this, the Examiner looked at a part of Schurenberg where it
6 said that an advance beneficiary notice screen may -- it may be presented to
7 the user if, if, if there's an indication that a test might not be paid.

8 Except that in Schurenberg we have this thick client, so there's no,
9 there's no explicit disclosure and there's no inherent necessity for
10 information to be, to be sent up to a central computer and then sent back
11 from, from a central computer requesting more information. That request
12 has to be transmitted across the network from a central computer, and the
13 Examiner has not pointed to any part of Schurenberg, and we've not found
14 any part of Schurenberg, that discloses or suggests that transmission will
15 take place.

16 This can all be done locally if you use the kind of thick client in a
17 distributive application such that -- such as Schurenberg describes. So these
18 are the kinds of limitations, limitations of whether data is transmitted or
19 received, where data is transmitted, where it, where it is transmitted -- sorry,
20 where it's sent to, where it's received from, and where portions of the
21 analysis are done. So regardless of the meaning of central computer, the fact
22 is that specific information has to be sent and received to a central computer
23 at specific times --

24 JUDGE MCCARTHY: If I might take you back to the Claim 26, first
25 off, you mentioned earlier that there was a time relationship between the, the
26 two process steps.

1 MR. GORDON: Yes.

2 JUDGE MCCARTHY: Could you elaborate on that a bit?

3 MR. GORDON: I don't believe I spoke about a specific -- I don't
4 believe I spoke about specific relationship between the two steps in the
5 process as we described them. What I did say and what I, I believe is very
6 important is that the transmission of information -- the second, the second
7 step in, in the claim as we, as we laid it out, transmitting information through
8 the network from the central computer where the information includes data
9 for generating a test requisition and a label for use within the, within the
10 biological specimen has to happen before the, before the test result is in.

11 You can't perform a test without having a test requisition. You can't
12 perform a test until you have a biological specimen.

13 JUDGE MCCARTHY: But isn't it simply necessary to the extent that
14 the information including data for generating the test requisition and label
15 for use is a patentable distinction that the -- simply that the information be
16 used in some manner or another in the, in the generation of the two?

17 MR. GORDON: I'm sorry, in the generation of the requisition?

18 JUDGE MCCARTHY: In the generation of the requisition and in the
19 label for the biological specimen.

20 JUDGE LORIN: Judge McCarthy is, is questioning a position you
21 took earlier in this hearing --

22 MR. GORDON: Yes.

23 JUDGE LORIN: -- when you stated that there's some structure in this
24 transmission -- in this information that's being transmitted --

25 MR. GORDON: Yes.

1 JUDGE LORIN: -- and I think what you mean by structure is this
2 phrase including data for generating, and the question is what is the
3 significance of this clause for generating test requisition, structurally
4 speaking, to the data that's being transmitted?

5 MR. GORDON: The significance is that it has to contain information
6 that is necessary to generate this requisition and to print this label, and it has
7 to happen at a time when generating the requisition and generating the label
8 would be, would be possible. And it's -- you know, it's not -- it doesn't
9 necessarily impose, you know -- it doesn't impose a lot of structure. It
10 doesn't -- it's not a very deep limitation, if you will, but it still limits the
11 claim in the ways that I have described.

12 I think a particular example of information would be a specimen
13 identification number. This is a particular, this is a particular piece of
14 information that is not going to necessarily be -- going to be included in a
15 test result because you don't -- it's going to be something that you're going
16 to want to keep until you have the results so that you can go back to the
17 specimen and make sure that you're testing the right one.

18 You can link it to a, you can link it to a requisition identifier, but once
19 you have the test result -- once it's in, you're not necessarily going to have a
20 use for a specimen identifier. But this is of critical importance for putting on
21 the label of the specimen container. And it's of importance when you get
22 the requisition you can look at the identifier on the specimen container and
23 you look at the requisition and make sure that you have the right, the right
24 container to go along with this requisition.

1 JUDGE LORIN: Well, I think we understand what you're intending
2 to do, but the claim calls for receiving information, data, actual data and
3 transmitting data.

4 MR. GORDON: Yes. I'm, I'm sorry, was that a question or, or --

5 JUDGE LORIN: That's an extension to our, our, our discussion here
6 about the, the structural significance of the clause generating a test
7 requisition and a label for use.

8 MR. GORDON: What --

9 JUDGE LORIN: I think might not --

10 MR. GORDON: Yes, we had --

11 JUDGE LORIN: My counterconstruction of the claim is that this
12 clause is really a discussion of what you're intending information --
13 intending the data to be used.

14 MR. GORDON: I think that you have to go back to how a statement
15 of, of purpose can limit a claim.

16 JUDGE LORIN: That's very true.

17 MR. GORDON: And, there --

18 JUDGE LORIN: That's why the question was what is the structural
19 significance --

20 MR. GORDON: And, right and --

21 JUDGE LORIN: -- of this -- use?

22 MR. GORDON: And I'm sorry, Judge Lorin, I believe that I had
23 answered that. If I did not answer that I'd be happy to, to go over that again.

24 JUDGE LORIN: No, I appreciate the earlier response. Thank you.

25 JUDGE CRAWFORD: Do you have any further questions?

26 JUDGE MCCARTHY: Yes. If I could turn to claim, I believe it's 49.

1 MR. GORDON: Yes.

2 JUDGE MCCARTHY: You have two items identified as a means for
3 receiving and a means for transmitting. Should we interpret those under
4 section 112, paragraph 6, and if so, what guidance can you provide us
5 concerning the corresponding structure in the specification?

6 MR. GORDON: Well, this was not something in view of the claims
7 says what it says, and there is a presumption, there is a presumption that
8 where you see the means for language that it has a particular meaning. This
9 was not something that came up at any point in prosecution, and it's not
10 something that I'm prepared -- it's not something that I prepared in advance
11 specifically for. I'm -- it's -- there is structure in the, there is structure in the
12 application there -- which is, which is the common hardware and software
13 that we expect in network computer systems.

14 It's the software that is described that carries out these methods.
15 Whether this is -- whether this implicates Section 112 as you've described is
16 not something that has come up before, and I'd certainly be happy to, I'd
17 certainly be happy to submit something, something to the panel if it would
18 be helpful.

19 JUDGE MCCARTHY: No, that won't be necessary.

20 MR. GORDON: But, it's -- you know, it says what it says and the
21 specification says what it says. And I think there is structure described in
22 the claims that describes both the transmitting and receiving means, and
23 whether that is a means for claim in 112 is, is a separate issue.

24 JUDGE CRAWFORD: You have further questions? Thank you.

25 MR. GORDON: You're welcome. Thank you.

26 (Whereupon, the hearing concluded on October 22, 2008.)